

Beiersdorf 722.1-HCL
100718-324

REMARKS

Amendment to the Claims

Claims 18, 19, 21, 22, 27 and 36 have been amended to include additional limitations to the claims. Claims 18-47 are still pending; it is believed that no new matter has been added.

35 U.S.C. 102 rejections

- (1) Claims 18-20 and 22-47 (prior to amendments) were rejected as being anticipated by Slavtcheff et al. (WO 00/56277).
- (2) Claims 18-20, 22-26 and 45-47 (prior to amendments) were rejected as being anticipated by Hewitt et al. (U.S. Patent 3,842,847).

While the applicants respectfully disagree with the Examiner's previous position with respect to anticipation, the applicants hold that even if these rejections did establish anticipation, they have been rendered moot with the current amendments to the claims as the prior art rejections do not teach every element of the claims as amended, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989)." see MPEP 2131. see also *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) "For a proper anticipation rejection, the reference "must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference."

35 U.S.C. 103 rejection

- (1) Claim 21 (prior to amendments) were rejected as being obvious over Slavtcheff et al., *id.* or Hewitt et al., *id.* in view of Müller et al. (WO 98/01109).

Claim 21, prior to the present amendments, included the limitations that the antiperspirant was aluminum chlorohydrate and that the agent effective against the production of sebum was selected from the group consisting of distarch phosphate and cyclodextrin. While respectfully disagreeing with the basis for the Examiner's obviousness rejection, in the interest of advancing prosecution, claim 21 (which is dependent upon claim 18) now requires that distarch phosphate and cyclodextrin are *simultaneously* present and requires the presence of a silicone oil.

Beiersdorf 722.1-HCL
100718-324

The Müller et al. reference, which appears to have been relied upon for their teachings related to starches, does not remedy the deficiencies of the Slavtcheff et al. or Hewitt et al. references. It is also noted that the Müller et al. reference was directed toward **hydroxyalkyl starches** or **hydroxyacyl starches** with a preferred embodiment being **hydroxypropyl** di-starch phosphate, **not** distarch phosphate which has a separate and distinct CAS Registration # - [55963-33-2] and was presumably well known in the art at the time the Müller et al. applications was being prosecuted. This point of distinction was apparently previously recognized by the Examiner who also happened to be an assistant examiner for the corresponding U.S. patent for the Müller et al. reference (i.e. U.S. Patent 6,248,338). However, even if Müller (or some other reference) had disclosed the known compound distarch phosphate, there is no teaching or suggestion to select distarch phosphate with the additions elements represented by the new claim limitations and to combine them with the Slavtcheff et al. or Hewitt et al. references.

- (2) Claims 27-29, 31-38 and 40-44 were rejected as being obvious over Hewitt et al., *id.* in view of Kropf et al. (U.S. Patent 6,316,030).
- (3) Claims 30 and 39 were rejected as being obvious over Hewitt et al. and Kropf et al., *id.* further in view of Jaeger et al. (abstract of DE 30 15 868).

While respectfully disagreeing with the basis for these rejections, in the interest of advancing prosecution, claims 27 and 36 have been amended to be dependent upon claim 18 and therefore have acquired the limitations set forth therein. The previous rejections are believed to have been rendered moot by these claim amendments.

NOTE: Applicants' reserve the right to recapture the subject matter surrendered by the above amendments in a divisional application.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of

Beiersdorf 722.1-HCL
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20422/US

a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 9 June 2004

By: Agata Gilinska
Agata Gilinska